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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/536,738	05/27/2005	Edward O'Connor	CON-101	4319
32205	7590	12/20/2005	EXAMINER	
CARMEN B. PATTI & ASSOCIATES, LLC ONE NORTH LASALLE STREET 44TH FLOOR CHICAGO, IL 60602			DOAN, PHUOC HUU	
			ART UNIT	PAPER NUMBER
			2687	

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/536,738	<b>Applicant(s)</b> O'CONNOR, EDWARD	
	<b>Examiner</b> PHUOC H. DOAN	<b>Art Unit</b> 2687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>05/27/2005</u> . | 6) <input type="checkbox"/> Other: ____.  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross (US Pub No: 2002/0132616) in view of Logan (US Pub No: 2002/0181671).

As to claim 1, 10, Ross discloses a mobile communication device “Fig. 1, item 14” for the communication of at least one audio file to a remote communication device “Fig. 1, item 22” over a communication network “Fig. 1, item 12” (page 2, par. [0019], par. [0021]).

However, Ross does not specifically disclose the device comprising: means for associating the at least one audio file with an identifier of the remote communication device; means for seeking and establishing a voice connection with the remote communication device via the identifier; and means for playing the associated audio file across the connection, upon establishing a connection with the remote communication device; the device being configured for telephonic voice

communication over the communications network and further comprising a microphone for the telephonic voice communication, and means for muting the microphone upon the device establishing the connection with the remote communication device.

In the same field of invention, Logan specifically discloses the device comprising: means for associating the at least one audio file with an identifier of the remote communication device (page 2, par. [0016]); means for seeking and establishing a voice connection with the remote communication device via the identifier (page 3, par. [0029]); and means for playing the associated audio file across the connection (page 1, par. [0015]), upon establishing a connection with the remote communication device (page 1, par. [0010]); the device being configured for telephonic voice communication over the communications network and further comprising a microphone for the telephonic voice communication (page 2, par. [0021]), and means for muting the microphone upon the device establishing the connection with the remote communication device (page 2, par. [0025] **“transmit prerecorded messages to a calling party when it is inappropriate for the cellular phone user to speak, such as when the phone “ring” in a silent “vibrate” mode”**). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide for muting the microphone

upon the device establishing the connection with the remote communication device as taught by Logan to the system of Ross in order to transmit pre-recorded messages “MIDI music files” from a cellular phone to a remote telephone.

As to **claim 2**, Logan further discloses the device of claim 1 wherein the identifier of the remote “**page 2, par. [0016]**” communication device is a phone number (**Fig. 3, item 330, page 4, par. [0040]**).

As to **claim 3**, Logan further discloses the device of claim 2 wherein the means for seeking a connection includes a means to automatically dial the phone number of the remote communication device at a predetermined time (page 2, par. [0016]).

As to **claim 4**, Ross further discloses all the limitations in page 3, par. [0025].

As to **claim 5**, Logan further discloses all the limitations in page 4, par. [0041].

As to **claim 6**, Logan further discloses all the limitations in page 5, par. [0044].

As to **claim 7**, Logan further discloses all the limitations in page 3, par. [0029].

As to **claim 8**, Logan further discloses all the limitations in page 3, par. [0028].

As to **claim 9**, Logan further discloses all the limitations in Fig. 1, and 2, page 2, par. [0024-0025].

As to **claim 11, 14**, Ross discloses a method of configuring a mobile communication device for communication of audio files over a communications network via the download of program code (Fig. 1, page 2, par. [0019-0021]), the

communication device having a microphone for telephonic voice communication (page 3, par. [0023]), the method comprising: storing the program code in a memory of the mobile communication device (page 2, par. [0019]); obtaining an audio file (page 2, par. [0019] **“audio profiling for the user”**).

However, Ross does not specifically disclose that linking the audio file with an identifier associated with a remote receiving communication device; seeking to establish a voice connection with the remote receiving communication device using the identifier, and upon establishing a voice connection with the remoter communication device, opening the audio file from the memory of the mobile communication device and playing the audio file to the remote communication device while muting the microphone.

In the same field of invention, Logan specifically discloses that linking the audio file with an identifier associated with a remote receiving communication device (page 2, par. [0016]); seeking to establish a voice connection with the remote receiving communication device using the identifier (page 3, par. [0029]), and upon establishing a voice connection with the remoter communication device (page 1, par. [0010]), opening the audio file from the memory of the mobile communication device **“page 1 through page 2, par. [0014-0016”** and playing the audio file to the remote communication device while muting the microphone (page

2, par. [0025] **“transmit prerecorded messages to a calling party when it is inappropriate for the cellular phone user to speak, such as when the phone “ring” in a silent “vibrate” mode).** Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide for muting the microphone upon the device establishing the connection with the remote communication device as taught by Logan to the system of Ross in order to transmit pre-recorded messages “MIDI music files” from a cellular phone to a remote telephone.

**As to claim 12,** Ross further discloses all the limitations in Fig. 1, page 2, par. 0021].

**As to claim 13,** Logan further discloses all the limitations in page 2, par. [0016].

**As to claim 15,** Logan further discloses all the limitations in page 1 through page 2, par. [0015-0016], [0021].

**As to claim 16,** Logan further discloses all the limitations in page 3, par. [0028].

**As to claim 17,** Logan further discloses all the limitations in page 3, par. [0028].

**As to claim 18,** Logan further discloses all the limitations in page 4, par. [0041]

**“the cellular telephone may be programmed to attempt to call the same number later when the called telephone does not answer or properly indicated that it is ready to receive the transmission”.**


*Conclusion*

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHUOC H. DOAN whose telephone number is 571-272-7920. The examiner can normally be reached on 9:30 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, LESTER G. KINCAID can be reached on 571-272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Phuoc Doan  
11/20/05

  
12/22/05  
LESTER G. KINCAID  
SUPERVISORY PRIMARY EXAMINER